

REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action mailed December 13, 2007. Claims 1-51 were pending in the present application and have been rejected.

Applicant has amended claims 1, 2, 8, 11, 16-18, 25, 28, 33-36, 42, 45, 50, and 51 and added new claim 52. Applicant submits that no new subject matter has been introduced by the amendments and the new claim and that support for the amendments and the new claim can be found in the specification. Claims 1-52 remain pending in this application after entry of this amendment.

Reconsideration of the rejections is requested based upon the remarks below.

INTERVIEW WITH EXAMINER

Applicant would like to thank Examiner Taylor and Examiner Nguyen (SPE) for the telephonic interview conducted for this application on February 11, 2008. Applicant has amended the claims and presented patentability arguments as discussed with the Examiners during the telephonic interview. A STATEMENT OF SUBSTANCE OF INTERVIEW is being filed herewith.

THE SPECIFICATION

The specification has been amended to update information about an application incorporated by reference in the present application. Applicant submits that no new subject matter has been introduced by the amendment.

THE CLAIMS

Rejections under 35 U.S.C. §103(a)

Claims 1-51 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chiu et al (U.S. Patent No. 6,452,615) (hereinafter "Chiu") and King et al (U.S. Patent No. 6,721,288) (hereinafter "King"). Applicant respectfully traverses the rejections.

Claim 1

Applicant submits that claim 1 is patentable over a combination of Chiu and King and has further amended the claim, as suggested by the Examiner, to more clearly distinguish the claim from Chiu and King. As amended, claim 1 recites:

1. A method of taking notes in a notes document using a note-taking device, the method comprising:
generating a first request at the note-taking device to insert a portion of a first information in a first location in the notes document, the first information comprising information captured by one or more capture devices;
determining if the portion of the first information requested by the first request is accessible to the note-taking device; and
storing the first request in the notes document upon determining that the portion of the first information requested by the first request is not accessible to the note-taking device.
(Applicant's claim 1, emphasis added)

As discussed with the Examiners during the telephone interview, with regards to the invention recited in claim 1, it is important to differentiate between a request and the information requested by that request. The invention in claim 1 relates to storing a request (as opposed to the information requested by the request) in a notes document upon determining that the information requested by the request is not accessible to the notes-taking device. Claim 1 specifically recites determining if the portion of the first information requested by the first request is accessible to the note-taking device and storing the first request in the notes document upon determining that the portion of the first information requested by the first request is not accessible to the note-taking device. For example, as depicted in Fig. 7A of the application, a request (pointed to by reference 704) is stored in the document. Applicant submits that at least the "determining . . ." and "storing . . ." features recited in claim 1 are not taught or suggested by Chiu and/or King, considered individually or in combination.

The Office Action alleges that the "determining . . ." step recited in claim 1 is taught by Chiu in col. 6 lines 28-34 and 50-54 and that the "storing the first request . . ." is taught by Chiu at col. 6 lines 50-54 and by King in the abstract, col. 6 lines 10-32 and col. 6 line 56 to

col. 7 line 6. Further, in the Response to Arguments section, the Office Action asserts, among other things, that

Chiu teaches a request generation process where a user creates a "request" that comprises, e.g., a link screenshot, and other characteristics that are particular to the underlying captured first information (see e.g., the items of Fig. 7).

... "request," which given the broadest reasonable interpretation of the claim language, would include a link combined with a screenshot and other information as taught in Chiu (see summary in col. 3 lines 30-57)

Applicant submits that in order to appreciate the differences between the embodiment recited in claim 1 and reference Chiu and King, it is important to differentiate between a request and the information requested by that request (i.e., differentiate between a request and what is requested by the request).

Chiu describes a note-taking device that enables media input streams to be retrieved for playback. Facilities provided by the note-taking device allow a user to capture stills from the media streams, make annotations, and reference important events that occur during a note-taking session. Thumbnails, snaps, and backgrounds may be created from the input media streams and are used to reference into the media streams which are stored for later playback. (Chiu: Abstract).

Accordingly, in Chiu, a user makes a request to capture a still from a media stream during a note-taking session. The resultant thumbnails, snaps, and/or backgrounds (depicted in Chiu: Fig 7) that are captured in the notes thus represent what is requested by the user -- not the request itself, as recited in claim 1. This is substantially different from claim 1, wherein the request itself -- not the portion of first information requested by the request -- is stored in the notes document, and upon determining that the portion is not accessible to the note-taking device. Accordingly, Applicant submits that the "storing . . ." feature recited in claim 1 is not taught or suggested by Chiu.

Moreover, Applicant submits that Chiu assumes that the note-taking device has access to the requested information and the user's request can be processed -- unlike claim 1, Chiu is not concerned and silent about what to do if the request cannot be processed. As a result,

there is no discussion in Chiu of determining whether the requested information is accessible or not, as recited in claim 1. Accordingly, Applicant submits that the feature recited in claim 1 of "determining . . ." is also not taught by Chiu. Consequently the "storing . . ." that is dependent upon the "determining . . ." is also not taught or suggested by Chiu.

Applicant further submits that the deficiencies of Chiu are not cured by King. King teaches three different techniques for reducing delays faced by users of mobile devices due to unavailability of wireless networks. A first technique allows mobile devices to communicate with remote servers using asynchronous communications, namely asynchronous requests. Such asynchronous communications allow the processing at a mobile device to continue while the asynchronous request is processed in the background. A second technique pertains to the use of content channels with mobile devices. The content channels are stored and retained in cache memory so that their resources are guaranteed to be locally available, regardless of availability of wireless networks. A third technique pertains to improved list processing within mobile devices such that lists can be manipulated without server interaction. (King: Abstract; col. 3 lines 30-57; col. 6 lines 10-32). Further, col. 6 line 56 to col. 7 line 6 of King, identified in the Office Action, merely describes the first technique that enables mobile devices to communicate with remote servers using asynchronous communications, namely asynchronous requests.

However, as discussed with the Examiners during the telephonic interview, the asynchronous communication technique described in King does not teach anything about determining if information requested by a request is accessible to a note-taking device and further storing the request in a notes document upon determining that the information requested by the request is not accessible to the note-taking device, as specifically recited in claim 1. Applicant submits that the description of asynchronous communication in King does not automatically teach or suggest the specific features recited in claim 1.

Accordingly, Applicant submits that even if Chiu and King were combined as suggested by the Office Action (even though there appears to be no motivation for the combination), the resultant combination would not make obvious the invention recited in

claim 1. In light of the above, Applicant submits that claim 1 is patentable over a combination of Chiu and King.

Claims 2-51

Applicant submits that independent claims 18 and 35 are allowable over a combination of Chiu and King for at least a similar rationale as discussed above for the allowability of claim 1, and others.

Applicant further submits that dependent claims 2-17, 19-34, and 36-51 that depend either directly or indirectly from claims 1, 18, and 35, respectively, are allowable over a combination of Chiu and King for at least a similar rationale as discussed above for the allowability of the independent claims.

Furthermore, the dependent claims recite additional features which make them patentable for additional reasons. For example, claims 8, 11, 17, 25, 28, 34, 42, 45, and 51 specifically recite embedding the requested portion of the captured information in the notes document. This is to be differentiated from merely inserting hyperlinks or indexes to the stored information as taught by Chiu. For example, as described in Applicant's specification

... the inserted data is actually embedded in the notes document--this is substantially different from hyperlinks that provide links to data. As a result, various operations that can ordinarily be performed on a document can be performed on the notes document. For example, the document can be copied, distributed, etc. (Applicant's specification, paragraph [0063])

Further, the deficiencies of Chiu with respect to claims 8, 11, 17, 25, 28, 34, 42, 45, and 51 are not cured by King. Accordingly, this is an additional reason for the allowability of these claims.

Further, claims 15, 32, and 49 recite inserting a visual marker in the first location in the notes document indicative of the first request. Applicant would like to emphasize that the visual marker is indicative of the request. Applicant submits that this feature is not taught by Chiu or King. The items depicted in Fig. 7 of Chiu (e.g., thumbnail 710, ink strokes 715, and snap 720, for example) are merely indexes to the stored video information and not visual markers indicative of a request as recited in claims 15, 32, and 49. Further, the deficiencies of Chiu with

respect to claims 15, 32, and 49 are not cured by King. Accordingly, this is an additional reason for the allowability of these claims.

New Claim

Applicant has added new claim 52 to claim an embodiment of the present invention. Applicant submits that new claim 52 is in a condition for allowance.

Amendments to the Claims

Unless otherwise specified, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the Specification as filed and do not add new matter.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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